

REMARKS

The applicant elects further prosecution before the Primary Examiner by the filing of this Amendment.

In paragraph 1 of the Office Action, claims 1-9 as being anticipated by 35 U.S.C. §102(a) as being anticipated by Antoni-Zimmermann et al. In paragraph 2 of the Office Action claims 1-9 were rejected under 35 U.S.C. §102(a) as being anticipated by Theis.

Reconsideration is requested.

The cited patent application was published on February 25, 1999 which is subsequent to the applicants European Patent application priority date of August 20, 1998. Attached to this Amendment is a certified translation of European Patent Application 98115723.3 and a translation of the German text of PCT application PCTEP/99/06056. Since these documents establish that the applicants are entitled to a filing date of August 20, 1998 which is prior to the Antoni-Zimmermann et al. or Theis publication dates of February 25, 1999 and February 3, 2000, it is requested that this ground of rejection be withdrawn. It is noted that WO 99/08530 is in effect the publication of the applicants and it is not prior art under 35 U.S.C. §102(a).

On page 5 of the Office Action, claims 1-9 were rejected under 35 U.S.C. §103(a) as being unpatentable over Valcke et al. (U.S. 5,714,507).

Reconsideration is requested.

The Examiner has applied the Valcke et al. reference as making obvious the claimed composition because Valcke et al. teach biocidal compositions "comprising the active ingredients (I) and (II) and further comprising other microbiocides. The "other microbiocides" include the applicants claimed combination as well as approximately some 200 biocides. There is no teaching in Valcke et al. that directs the skilled

artisan to the combination of 2-methylisothiazolin-3-one, 3-iodo-2-propynyl-N-butylcarbamate and a polar or non-polar liquid medium as pointed out in claim 1 of the present application.

Claims 1 and 5-8 are patentable for the following reasons:

The claim language that the applicants have adopted recites that the claimed composition "consists essentially of" the recited components. This terminology has been recognized by the courts and the Patent and Trademark Office as excluding additives that would have a material effect on the basic and novel characteristics of the claimed invention. In re Janakirma Rao, 137 USPQ 256 (CCPA 1963); Water Technologies Corp. v. Calco, Ltd., 7 USPQ2d 1097 (Fed.Cir. 1988).

The Valcke et al. patent is concerned with a composition of (I) and (II). Compound (I) is identified as metconazole and compound (II) is identified as a triazole. Nothing in the applicants' specification points to metconazole and a triazole as being the a part of the claimed invention. The Valcke et al. compositions must contain these materials as active biocides or one does not utilize the explicit teachings of Valcke et al.

In making the rejection under 35 U.S.C. §103 in Paper No. 8, the Examiner commented that the claims were drawn to a biocide composition containing 2-methylisothiazolin-3-one and 3-iodo-2-propynyl-N-butylcarbamate in combination and excluding 5-chloro-2-methylisothiazolin-3-one. The Valcke et al. reference was applied as teaching biocide compositions "comprising the active ingredients" and "further comprising other microbiocides such as 3-iodo-2-propynyl-N-butylcarbamate and isothiazolinones such as N-methylisothiazolin-3-one.

In response to this rejection, the claims were amended to point out that the claimed composition "consists essentially of" the recited ingredients. The accompanying REMARKS, in the Amendment dated February 1, 2002, pointed out that the language "consisting essentially of" was adopted to exclude the essential components of the cited reference which are

metconazole and a triazole.

In the Final Rejection, the Examiner stated that the term "consisting essentially of" fails to exclude the presence of metconazole and a triazole from the applicant's amended claims because since metconazole is required by the Valcke et al. patent, it would not materially affect the instantly claimed composition which is fungicidal. In support of the rejection, the Examiner cited MPEP §2111.03.

MPEP §2111.03 explicitly points out that the term "consists essentially of" limits the claim to the specified ingredients and those that do not materially affect the basic and novel characteristics of a composition. The case of In re Herz and Willis, 190 USPQ 461 (Fed. Cir. 1986) was cited in MPEP §2111.03 as an illustration of how the term "consisting essentially of" is to be construed. At page 463 of the Herz decision, the court stated that:

"Therefore, in construing the phrase 'consisting essentially of', in appellants claims it is necessary and proper to determine whether their specification reasonably supports a construction that would include additives..." 190 USPQ at p.463 (emphasis added)

Based on the explicit language of the cited case, the Examiner must look to the applicants' specification and not to the specification of the cited reference in order to construe the meaning of the term "consisting essentially of". When the applicant's specification is reviewed, there is no mention of the addition of metconazole or a triazole, even though other additives are mentioned. For this reason, the Examiner's construction of the applicants' claims is erroneous.

In addition, any burden that the present applicants may have in showing that the introduction of additional components would materially change the characteristics of the applicants' composition invention is met by the fact that Valcke et al. claims the addition of metconazole and a triazole has a fungicidal effect. Based on the disclosed activity of the

metconazole/triazole combination by Valcke et al., one would assume that if one did not use these materials the effects that were claimed for the combination would not be achieved. This disclosure by Valcke et al. provides evidence of the material effect of the presence of metconazole and a triazole.

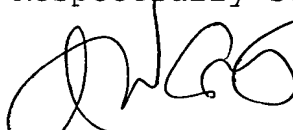
Claims 2-4 and 9 point out specific ratios of the recited materials. These claims are patentable for the reasons set forth above for the patentability of claims 1 and 5-8 and for the further reason that the numerical ratios are not found in the Valcke et al. reference which only specifies ratios for the metconazole and triazole components. A finding of obviousness for the use of specific ratios of biocides is not proper when the cited reference is silent as to the amounts of these materials that are to be used.

Table I-XII of the present application provide performance data for the claimed combination. This data was obtained using ratios of materials within the scope of claims 2-4 and 9, without the use of the metconazole or triazole components of the prior art compositions. The synergy index as reported in Tables II, IV, VI, VIII, X and XII is persuasive of the unexpected advantages that are obtained by the claimed combination of biocides. This is further indicia of the non-obviousness of the claimed invention.

New claims 10-16 point out the invention in terms that recite a composition that "consists of" the recited components. These claims unequivocally exclude the prior art and define patentable subject matter.

An early and favorable action is earnestly solicited.

Respectfully submitted,



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